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EXAMINER

GILBERT, WILLIAM V

ART UNIT PAPER NUMBER

3635

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/737,345	Applicant(s) NIEMCZYK, ANDREW	
	Examiner William V. Gilbert	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/15/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

Page 9, paragraph 0038, elements 137 and 238.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "29" has been used to designate both **the radius section (Page 7, paragraph 0029)** and, **per Figure 2, what appears to be an overlap of the corner (30) and the plate (24)**. Corrected drawing sheets in compliance with

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37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:

Figure 8, element 24 is noted as a modified plate member (see Page 9, paragraph 0038). Examiner believes Applicant intended this element to be 124.

Figure 10, element 337 is not provided in the disclosure. Appropriate correction is required.

Claim Objections

3. **Claim 4** is objected to because of the following informalities:

Line 2, the Claim is for a "water **permeable**...member". Examiner believes the Claim should read "water impermeable...member", based on the Specification and Claim 1, and the Claim was examined with this understanding.

Line 2, the Claim is for a "**semi-flexible** water [im]permeable...member", and line 7 claims the same member to be **flexible**. Applicant should specify which is appropriate and insure that any proper antecedent base is provided.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding Claims 1, 4 and 9 Applicant claims a basement wall water protection system where a long leg of the system extends away the basement wall at a distance at least as great as the tangent of 15 degrees times the height of the basement wall below the impermeable flexible member. Per Claims 1, 4 and 9, however, Applicant claims only the basement wall water protection system, not the basement wall itself. It is therefore vague and indefinite because the Claims include a calculation (15 degrees times the height of the basement wall below the member) that does not properly include a reference (the basement wall) from which to base its calculation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rose (U.S. Patent No. 5,248,225).

Regarding Claim 10, Rose discloses a method of protecting a basement wall from water (Column 7, lines 49-51), comprising

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digging ground to form a trench (on the exterior side of the basement wall) with the trench wide enough to receive a semi-flexible member (Column 7, lines 52-60; See Figure 2), placing overlapping water impermeable semi-flexible members (Figure 5, elements 10a, 10b, 10c, 10d; Column 4, lines 29-32) in the trench with a short leg (see element "A" from attached Figure 2 from Rose below) of each member (abutting against the basement wall) and having a long leg (see element "B" from attached Figure 2 from Rose below) extending substantially away from the basement wall (See Figure 2, generally; see Column 8, lines 9-20), and backfilling the trench with soil above the water impermeable members (Column 8, lines 35, 36).

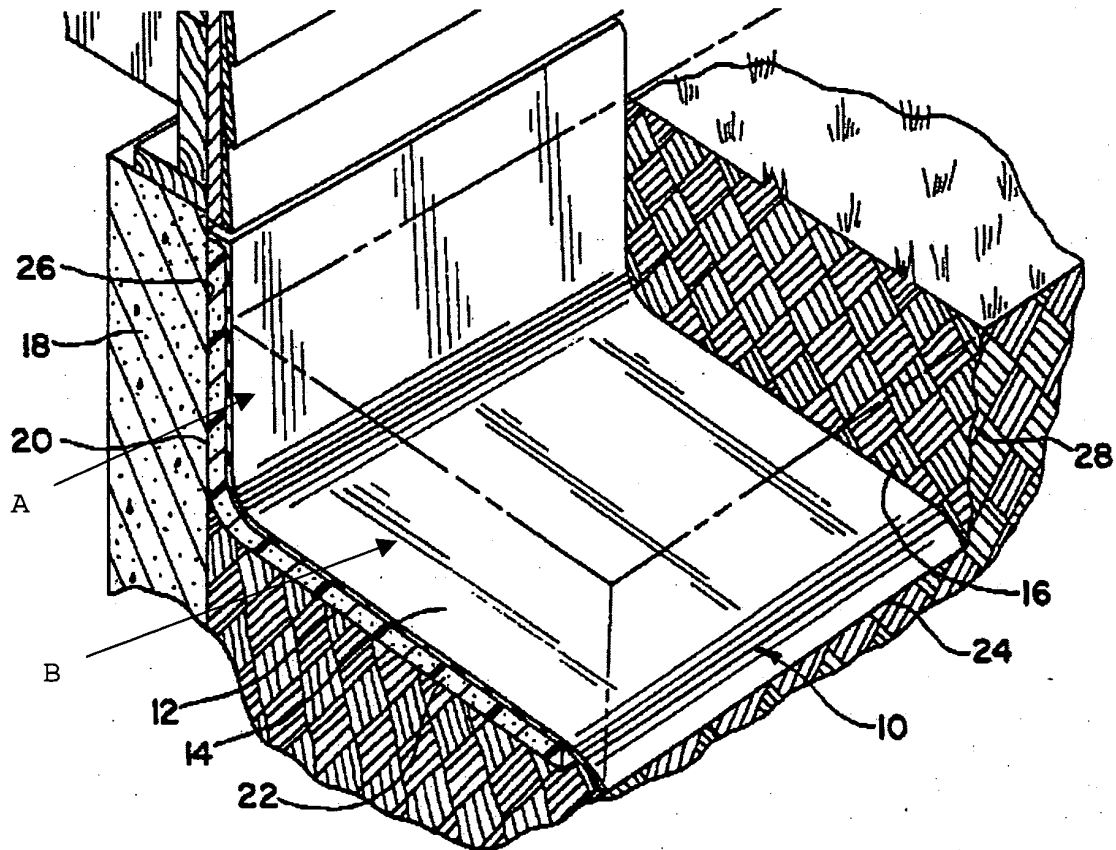


Figure 2 from Rose

Regarding Claim 11, Rose discloses shaping the bottom of the trench to decline at a 5-degree slope away from the basement wall (Column 5, lines 29-37). While the prior art does not specifically disclose the slope to be 5-degrees, the slope rate of 1 inch per 1 foot (12 inches) provides for a slope that is approximately 5-degrees. The calculation was provided through trigonometry as follows:

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Angle = (inverse tangent)*(rise/run)

Angle = (inverse tangent)*(1/12)

Angle = 4.76 degrees = approximately 5 degrees

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 4, 5, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose.

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Regarding Claims 1 and 4, Rose discloses a basement wall water protection system (14) comprising at least one (or a plurality of, per Claim 4) water impermeable flexible member(s) (Column 2, lines 44-46; Column 4, line 43; Figure 5), having a short leg section (see "A" from attached Rose Figure 2 above) and a long leg section (see "B" from attached Rose Figure 2 above) extending away from the basement wall (see Figure 2, generally; see **Claim Rejections - 35 USC § 112** above regarding the statement about the "basement wall"), a first side edge (14a, per Claim 4) and a second side edge (14b, per Claim 4) that can join each other to form a watertight joint (Column 6, lines 49-52, per Claim 4). While Rose discloses the dimensions of the waterproof member to be approximately 4'6" by 8'6" (Column 4, lines 60-63), Rose does not disclose the long leg section extending at a calculated distance at least as great as the tangent of 15 degrees times the height of the basement wall below the impermeable flexible member (see **Claim Rejections - 35 USC § 112** above regarding the statement about the "basement wall"). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the dimension of the long leg in Rose as calculated in the Claim because the Applicant's Specification (Page 7, paragraph 0031) states that the length of the long leg could be approximately

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14.5 inches if the long leg is placed with 4'8" of wall below it, and a long leg of 32 inches is long enough for most commercial applications. The dimensions of the member in Rose provide the obvious capability of meeting these dimensions of the Claim. Further in Claim 4, the phrase "short leg section that is abutable against an upper portion of basement wall and a long leg section extending substantially away from said basement wall," is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Figure 2 in Rose clearly shows that the prior art is capable of meeting the claim.

Regarding claim 5, Rose discloses a short leg (see "A" from attached Figure 2 from Rose, above). The phrase, "being placed below ground level and free to move against said basement wall and held against said wall solely by ground pressure" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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Here, the short member in Rose is capable of meeting the Claim in that it can be placed below ground level (Figure 3, generally) and held against a wall by solely ground pressure (Figure 3, generally).

Regarding Claim 8, Rose discloses corner members (10c) overlapping the respective water impermeable members (Figure 5, the connection of 10c and 10d).

Regarding Claim 9, Rose discloses the long leg (see "A" from attached Figure 2 from Rose, above) extending away from the basement wall at approximately a 5-degree downward slope (Column 5, lines 29-37; see Claim 11 rejection above for calculation). Regarding the phrase "extending at least approximately the height of the basement wall below the leg times the tangent of 15 degrees", see rejections of Claims 1 and 4, above; see **Claim Rejections - 35 USC § 112**).

Claims 2, 3, 6, 7, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose in view of Hill (U.S. Patent No. 6,517,285).

Regarding Claim 2, Rose discloses the claimed invention except the first side edge (14a) and second side edge (14b) are complimentary such that they may snap-fit. Hill discloses an apparatus for retaining water in a confined area using an impermeable membrane (40) having a first side edge (32) and

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second side edge (33) that are complimentary to form a snap fit (Figure 3, generally). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the snap connection in Hill with the edges in Rose. One would have been motivated to make such a modification because the snap-fit connection in Hill is functionally equivalent to the connection in Rose and would perform equally as well. The phrase "to form a watertight junction" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The snap-fit connection in Rose has the capability to form a watertight seal since it encompasses the entire length of the side of the membrane as opposed to multiple snap connections spaced at given intervals along the length of the side of the membrane. Further, Figure 3 shows no open space between the two connecting members (32,33), which would provide for a watertight seal.

Regarding Claims 3 and 6, Rose discloses the claimed invention except that the member (10) is made of polyethylene plastic. Rose discloses an impermeable membrane (40) made of

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polyethylene plastic (Column 5, lines 52-57). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the member in Rose out of polyethylene plastic as disclosed in Hill. One would have been motivated to make such a modification because polyethylene plastic is functionally equivalent to the member in Rose and would perform equally as well.

Regarding Claim 7, the phrase "each of said member being positionable about 16 inches below ground level with the short leg member abutable against said basement wall", is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, the member (10) in Rose is capable of being placed at any depth abutable to a basement wall (see Rose Figure 2, generally).

Regarding Claim 12, Rose discloses the claimed invention except the step of interlocking adjacent members to each other at the edges of each member. Hill discloses interlocking adjacent members (30, 30a) to each other at the edges (32, 33) of each member. It would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to use the method of connecting the members in Hill with the members in Rose. One would have been motivated to make such a modification because these interlocking members are functionally equivalent to the connection in Rose and would perform equally as well.

Regarding Claim 13, Rose discloses planting plants in the backfilled soil above the water impermeable members (Column 5, lines 29-32).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Oakley (U.S. Patent No. 6,224,700).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571.272.6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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